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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92066968
Party	Defendant Software Freedom Conservancy
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Submission	Opposition/Response to Motion
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Signature	/Pamela S Chestek/
Date	01/03/2018
Attachments	Opposition to Motion to Amend Petition final.pdf(399332 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 4212971
Mark: SOFTWARE FREEDOM CONSERVANCY
Registration date: September 25, 2012

Software Freedom Law Center

Petitioner,

v.

Software Freedom Conservancy

Registrant.

Cancellation No. 92066968

**REGISTRANT’S OPPOSITION TO PETITIONER’S MOTION FOR LEAVE TO AMEND AND
TO TOLL THE TIME TO RESPOND TO REGISTRANT’S MOTION FOR SUMMARY JUDGMENT**

Introduction

Software Freedom Law Center (“SFLC”) has moved for leave to amend its Petition for Cancellation and to toll the deadline for its response to a motion for summary judgment filed by Registrant Software Freedom Conservancy (“Conservancy”). On December 29, 2017 the Motion for Summary Judgment was denied as moot,¹ thus the SFLC’s motion to toll the time is also moot.

SFLC has moved that it be allowed to amend its petition to plead a second ground for cancellation, fraud.² However, Petitioner also substantively amended a number of paragraphs relating to

1 8 TTABVUE.

2 7 TTABVUE 1.

the original § 2(d) basis of its petition. A red-line comparison of the original Petition and the proposed amended Petition is attached as Exhibit A. Conservancy does not contest the amendment relating to likelihood of confusion, which is in paragraphs 1-25. Respondent, however, opposes the addition of a new count for fraud because the proposed amendment fails to state a claim and therefore the addition of the new count would be futile.

Statement of Facts

As noted, the original petition alleged only likelihood of confusion as the basis for cancellation. The motion and its attached proposed amended petition allege two theories for the fraud count. First, SFLC alleges that Conservancy was aware of the SFLC's registration for SOFTWARE FREEDOM LAW CENTER and therefore Conservancy's statement in its declaration that "to the best of [the signatory's] knowledge and belief no other person, firm, corporation or association has the right to use the [Conservancy] mark in commerce, either in identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive," was fraudulent.³ This theory is not reflected in the petition, but to be thorough the Respondent will address it.

SFLC's second theory is that Conservancy was obliged to claim legal services in its trademark application or advise the examining attorney that it offered legal services, and not doing so was a false statement made to the examining attorney.⁴

The parties' goods and services are:

3 7 TTABVUE 3.

<u>Mark</u>	<u>Goods and Services</u>
SOFTWARE FREEDOM LAW CENTER	Class 45: Legal services
SOFTWARE FREEDOM CONSERVANCY	<p>Class 9: Downloadable computer software for media file management, object-oriented software engineering, messaging, software development tools, operating system utilities, operating system emulation, inventory management, graphics modeling, Braille displays, implementation of dynamic languages, print services, browser automation, operating systems programs in the field of education, and computer operating system tools for use in embedded systems, provided freely and openly licensed use for the public good.</p> <p>Class 35: Charitable services, namely, promoting public awareness of free, libre and open source software projects, and developing and defending the same.</p>

The trademark application SOFTWARE FREEDOM CONSERVANCY was initially refused under Section 2(e)(1) of the Trademark Act.⁵ The Office Action also said “The trademark examining attorney has searched the Office’s database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).”⁶

⁴ 7 TTABVUE 27, ¶¶ 46-47. SFLC also finds it worth stating that, after this petition was filed, Conservancy filed two intent-to-use applications for a new mark. 7 TTABVUE 27, paras. 48-50, but Conservancy does not know why SFLC finds this relevant to a fraud theory.

⁵ TSDR Jan. 30, 2012 Office Action.

⁶ *Id.*

Argument

I. Legal Standard for a Motion for Leave to Amend

While the Board should freely give leave to amend where justice so requires, Fed. R. Civ. P. 15(a) (2), TBMP § 507.01, the amendment will be denied if allowance of the amendment would be futile. *See Forman v. Davis*, 371 U.S. 178, 182 (1962); *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm'r Pats. 1977). The petitioner's proposed fraud count fails to state a claim and therefore the amendment would be futile. Petitioner's motion with respect to the fraud count, paragraphs 26-51 of the proposed amended petition, should therefore be denied.

II. The Proposed Amendment Does Not State a Claim For Fraud

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes specific false, material representations of fact in connection with an application to register with the intent of obtaining or maintaining a registration to which it otherwise is not entitled. *In re Bose Corp.*, 580 F.3d 1240, 1243, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009). The nature of the charge of fraud requires that it be proven "to the hilt" with clear and convincing evidence. *Id.* "There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Id.* "[A] cancellation claim that the registration 'was obtained fraudulently' requires more than a false representation; it requires, *inter alia*, that the false representation be accompanied by deceptive intent." *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1524 (TTAB 2016). The standard for finding intent to deceive is stricter than the standard for negligence and even gross negligence. *In re Bose Corp.*, 580 F.3d at 1244-45, 91 USPQ2d at 1940-41.

A. Knowledge of a Prior Registration For a Different Mark For Different Services Is Not Fraud

“[F]raud will not lie against an applicant who holds an honest, good faith belief in its right to register a mark and signs an application with the statutorily prescribed ownership statement, which is phrased in terms of subjective belief.” *Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146 (TTAB 2016) (citing *Woodstock’s Enters. Inc. (California) v. Woodstock’s Enters. Inc. (Oregon)*, 43 USPQ2d 1440, 1443 (TTAB 1997), *aff’d*, 152 F.3d 942 (Fed. Cir. 1998)). To prevail on a fraud claim that the declaration or oath in a defendant's application for registration was executed fraudulently, the party claiming fraud must allege particular facts, which, if proven, would establish that: (1) there was in fact another user of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to respondent’s; (3) respondent knew that the other user had rights in the mark superior to respondent’s, and either believed that a likelihood of confusion would result from respondent’s use of its mark or had no reasonable basis for believing otherwise; and that (4) respondent, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled. *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768 (TTAB 2010).

Simply enough, awareness of another’s registration for a different mark for different goods and services is not a sufficient basis for alleging fraud:

The difficulty with respondent's pleading of fraud is that respondent's registration was on the register, and thus presumably known to the Examiner of Trademarks, at the time when the Examiner of Trademarks was considering petitioner's right to registration. Thus it is manifest that the circumstances set forth by respondent in its pleading of fraud are not of such nature as to represent a willful withholding by petitioner of facts which, if transmitted and disclosed to the Examiner, would have resulted in the disallowance of the registration sought.

But however that may be, an applicant's failure to disclose to the Examiner of Trademarks the asserted rights of another person cannot be said to constitute fraud unless such other person was known by applicant to possess a superior right to use the same or a substantially identical mark for the same or substantially identical goods or services as those in connection with which registration is sought. That is to say, where there is an arguable difference between applicant's mark sought to be registered and the asserted mark of another person, so that applicant may reasonably believe that the contemporaneous use of such marks by the parties is not likely to cause confusion, no fraudulent intent can be inferred from applicant's averment that no other person, firm, corporation or association has the right to use the involved mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake or to deceive.

SCOA Indus. v. Kennedy & Cohen, Inc., 188 USPQ (BNA) 411, 414 (TTAB 1975); *Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1207 (TTAB 1997) ("If the parties' respective marks and goods or services are not substantially identical, then the applicant has a reasonable basis for believing that contemporaneous use of such marks by the parties, on or in connection with their respective goods or services, is not likely to cause confusion. The applicant's averment of that reasonable belief in its application declaration or oath is not fraudulent."); *Space Base, Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220 (TTAB 1990) (no fraud where the party charged with fraud did not advise the examining attorney of an earlier-filed application and its opposition to it); *cf. Colt Indus. Operating Corp. v. Olivetti Controllo*

Numerico S.p.A., 221 USPQ 73, 76 (TTAB 1983) (stating that there can be no fraud where priority was disputed).

The two marks and the parties respective goods and services are far from “same or substantially identical,” notwithstanding non-specific, unsupported allegations that Conservancy admitted confusion.⁷ The marks share the same descriptive term, “software freedom,”⁸ following by words that are both quite different, “law center” and “conservancy,” and that also describe the services offered by the respective parties. Nor are the parties’ goods and services the same or substantially identical; in fact they aren’t even in the same International Class.

The unusual facts of this particular case further show that there cannot possibly be fraud by filing the trademark application. SFLC created Conservancy, one that was independent from it by design, picked the name for the entity, and did the corporate formation work that created it.⁹ It beggars belief that SFLC would create an entity and yet that entity, the Respondent, should for some reason think that it couldn’t take the natural step of registering the trademark for the name it was given. Conservancy had every reason to believe that the contemporaneous use of the SFLC and Conservancy mark would not

7 1 TTABVUE ¶ 22.

8 See *Software Freedom*, Wikiversity, https://en.wikiversity.org/wiki/Software_Freedom (last visited Dec. 29, 2017); Software Freedom Day, <https://www.softwarefreedomday.org/> (last visited Dec. 29, 2017); cf. *What is Free Software*, GNU Operating System (Apr. 4, 2017), <https://www.gnu.org/philosophy/free-sw.en.html> (describing the “four essential freedoms” for software).

9 1 TTABVUE ¶¶ 10, 15.

cause confusion and there is no fraud by Conservancy's application for the registration of SOFTWARE FREEDOM CONSERVANCY.

B. Conservancy Was Not Obligated to Apply to Register Its Mark for Legal Services

SFLC presumes a duty that does not exist, that one must register a trademark for all the services that one performs. Counsel for Conservancy could not locate any statement of such a duty and the theory is inconsistent with common sense. If one could not pick and choose what to register a trademark for, no company could manage its trademark registration budget, being forced to file applications for minor (or even income-losing) goods and services. It is also inconsistent with many aspects of trademark registration, opposition and cancellation practice. See, for example, TMEP § 1402.11(b), which states for an identification listing "Information Services" that "An applicant is not required to register in all classes in which it provides information, but may instead choose to register only the classes of the fields that are most important to it." *See also* TMEP § 1401.04(b) (stating that an applicant should limit its goods and services to items in the classes for which filing fees were paid); TMEP § 806.02(d)(i) (stating that where a refusal is specifically limited to particular goods/services/classes, an applicant can abandon the refused ones and register the rest of the goods and services in the application); *cf.* TMEP § 707 (allowing examining attorney to contact applicant and suggest amending a vague or indefinite identification to overcome a likelihood of confusion refusal).

The claim that Respondent was obliged to claim legal services in its application is also contrary to the Board's practice of allowing an amendment to the scope of the identification of goods and services opposed under § 2(d) and subsequently allowing the application, as amended, to register. *See, e.g.,*

Embarcadero Techs., Inc. v. RStudio, Inc., 105 USPQ2d 1825, 1840-41 (TTAB 2013) (holding there was likelihood of confusion with original goods but allowing registration for amended goods that narrowed some of the original goods and services and deleted others). There simply is no duty to file applications for any goods or services except those that an applicant chooses. *Cf. Space Base, Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220 (TTAB 1990) (“We believe that there can be no fraud as a matter of law by reason of opposer's use in its identification of the phrase, "information storage and retrieval services", inasmuch as the services upon which opposer is alleged to actually use its mark are encompassed by that description.”)

Nor, for purposes of trademark examination, does it matter what other goods and services an applicant may have that it has not claimed in the registration. “[I]n a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be.”

Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (stating it is improper to compare the registrant's actual use, which was narrower than the services described in the registration, to the applicant's use). For there to be fraud in procuring a trademark registration, the statement made (or not made) to an examining attorney must be a specific false, material representation of fact. *In re Bose Corp.*, 580 F.3d at 1243, 91 USPQ2d at 1939. Materiality of any false application statement is determined in the context of whether the false statement is critical to the Trademark Examining Attorney's decision to approve a mark for publication. *Standard Knitting*,

Ltd. v. Toyota Jidosha Kabushiki Kaisha, 77 USPQ2d 1917, 1926 (TTAB 2006). A statement cannot be material if it is something the examining attorney is not even allowed to consider when examining the application. This theory, also, does not state a claim for fraud in the application.

Conclusion

For all the reasons given above, the Petitioner's Motion for Leave to Amend with respect to the added count for fraud, paragraphs 26-51, must be DENIED as futile.

Respectfully submitted,

Dated: January 3, 2018

By: 

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO AMEND AND TO TOLL THE TIME TO RESPOND TO REGISTRANT'S MOTION FOR SUMMARY JUDGMENT has been served on Software Freedom Law Center by mailing said copy on January 3, 2018, via electronic mail to:

Daniel Byrnes
Software Freedom Law Center
1995 Broadway, 17th Floor
New York, NY 10023

Email: dbyrnes@softwarefreedom.org

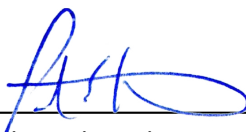
By:  _____
Pamela S. Chestek

Exhibit A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 4,212,971

For the mark: SOFTWARE FREEDOM CONSERVANCY

Registered: September 25, 2012

----- X

Software Freedom Law Center, Inc.,

Petitioner,

v.

Software Freedom Conservancy, Inc.,

Registrant.

Cancellation No. [92066968](#)

----- X

FIRST AMENDED PETITION FOR CANCELLATION

Software Freedom Law Center (“Petitioner”), a 501(c)(3) tax exempt not-for-profit corporation having its principal place of business at 1995 Broadway, 17th Floor, New York, NY 10023, believes that it has been and will continue to be damaged by U.S. Trademark Registration No. 4,212,971 for the mark SOFTWARE FREEDOM CONSERVANCY, and hereby petitions to cancel the same pursuant to Section 14 of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1064.

As grounds for cancellation, Petitioner alleges as follows:

1. ~~Petitioner~~[Petitioner](#) is a not-for-profit law firm that provides pro-bono legal services to protect and advance free and open source software (FOSS).
2. Petitioner is the owner of valid and subsisting United States Trademark Registration No.

3,913,979 on the Principal Register in the United States Patent and Trademark Office (“USPTO”) for the service mark SOFTWARE FREEDOM LAW CENTER (hereinafter “SOFTWARE FREEDOM LAW CENTER Mark”) for LEGAL SERVICES, which issued on February 1, 2011, and has become incontestable within the meaning of Section 15 of the Lanham Act, 15 U.S.C. § 1065. Attached as Exhibit 1 is a true and correct printout from the USPTO electronic database showing the current status and title of the registration as of September 22, 2017.

3. Petitioner has used the SOFTWARE FREEDOM LAW CENTER Mark in interstate commerce in the United States continuously since February 9, 2005 in connection with the provision of legal services.

4. As a result of widespread, continuous, and exclusive use of the SOFTWARE FREEDOM LAW CENTER Mark to identify its legal services and the Petitioner as their source, Petitioner owns valid and subsisting federal statutory and common law rights to the SOFTWARE FREEDOM LAW CENTER Mark.

5. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark is distinctive to both the consuming public and Petitioner's trade.

6. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark is symbolic of extensive goodwill established by Petitioner, and has acquired a high degree of recognition through continued use and expenditures of time, effort, and money, and serves as a unique identifier of the services offered by Petitioner.

7. Upon information and belief, Registrant, Software Freedom Conservancy, with an address at 137 Montague Street Suite 380, Brooklyn, New York 11201, and an email address at tony@softwareconservancy.org, is the current listed owner of Registration No. 4,212,971 for the mark SOFTWARE FREEDOM CONSERVANCY, in connection with “Downloadable computer software for media file management, object-oriented software engineering, messaging, software development tools,

operating system utilities, operating system emulation, inventory management, graphics modeling, Braille displays, implementation of dynamic languages, print services, browser automation, operating systems programs in the field of education, and computer operating system tools for use in embedded systems, provided freely and openly licensed use for the public good” in International Class 9, and “Charitable services, namely, promoting public awareness of free, libre and open source software projects, and developing and defending the same” in International Class 35. That trademark registration, based on an application filed on November 29, 2011, was issued on September 25, 2012 and bears a first-use date of September 17, 2005.

8. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark has priority over Registrant's mark because Petitioner's first-use and registration dates for the SOFTWARE FREEDOM LAW CENTER Mark predate the filing date of Registrant's application for Registration No. 4,212,971 or any other date on which the Registrant may rely for purposes of priority.

9. Karen M. Sandler, an attorney employed by Petitioner from on or about October 31, 2005 through on or about June 21, 2011, filed the application for the SOFTWARE FREEDOM LAW CENTER Mark with the USPTO on Petitioner's behalf on June 17, 2010.

10. Registrant was established ~~on April 3, 2006~~ by employees of Petitioner, ~~including Bradley M. Kuhn~~. Registrant's articles of incorporation were filed on March 20, 2006. It was created as a legal entity separate from Petitioner in order to provide free financial and administrative services to FOSS projects and developers.

11. At its inception, the organization's formation, all of Petitioner's board members were employees of Petitioner. Eben Moglen, President, Chairman of the Board, and Director of Petitioner, chaired the Board of Registrant ~~had one board member in common, and, Registrant's business address was the address of Petitioner. All Registrant's expenses were paid for out of the budget of Petitioner.~~
Employees of Petitioner, including Karen M. Sandler and Bradley M. Kuhn, ~~served~~ were appointed as

officers of Registrant ~~on a volunteer basis.~~

12. Having created, paid for, and devoted its resources, including employees and office space, to

Registrant, Petitioner had a right to use the SOFTWARE FREEDOM CONSERVANCY Mark. There was no implied exclusivity in Registrant's use of the SOFTWARE FREEDOM CONSERVANCY Mark.

11.13. Upon information and belief, Karen M. Sandler and Bradley M. Kuhn, have continuously served as Registrant's officers since leaving the employ of Petitioner.

12.14. Bradley M. Kuhn was employed by Petitioner from March 2005 to September 30, 2010.

13.15. Bradley M. Kuhn was appointed as the ~~full-time~~ executive director of Registrant on October 4, 2010.

~~By May 2~~

14.16. After January 20, 2011, Petitioner and Registrant ~~no longer~~ had any~~no~~ board members in common.

~~between them.~~

~~From approximately July of~~
~~15.17. After June 21, 2011-onwards,~~ Registrant ~~was operated completely independently from and~~

Petitioner, ~~the two organizations having had~~ no ~~board members,~~ officers, or employees in common.

GROUND

FIRST GROUND FOR CANCELLATION – LIKELIHOOD OF CONFUSION

~~16.18.~~ Petitioner hereby incorporates by reference paragraphs 1 through ~~16~~17 as if fully stated here.

~~17.19.~~ Registrant's SOFTWARE FREEDOM CONSERVANCY Mark is confusingly similar to Petitioner's SOFTWARE FREEDOM LAW CENTER Mark. Both marks incorporate the identical element "Software Freedom" at the beginning of the mark, followed by a descriptive noun or compound noun. The appearance and sound of the two marks are initially identical when read or pronounced. These first two identical words thus comprise the dominant portion of each of the marks both in terms of their salience as well as in the number of letters.

~~18.20.~~ There are no other registered trademarks on the primary register of the USPTO that incorporate the element "Software Freedom" other than those of Petitioner and Registrant.

~~19.21.~~ The services provided by Petitioner and Registrant are related in significant ways: both entities offer support services for FOSS projects and developers.

~~20.22.~~ Registrant's services with which it uses the SOFTWARE FREEDOM CONSERVANCY Mark are offered to the same class of consumers as Petitioner's services with which it uses the SOFTWARE FREEDOM LAW CENTER Mark, namely FOSS projects and developers.

21,23. There have been several instances of actual confusion between Petitioner's and Registrant's marks, including on websites, message boards, in phone calls to Petitioner, and in donation queries, and such confusion is likely to continue to occur.

22,24. Actual confusion has been acknowledged by Karen M. Sandler and Bradley M. Kuhn during public podcasts recorded while employed by Petitioner.

23,25. Registrant's registration should be canceled because it consists of or comprises a mark which so resembles Petitioner's previously used and registered SOFTWARE FREEDOM LAW CENTER Mark as to be likely, when used in connection with Registrant's goods and services, to cause confusion, mistake, or deception within the meaning of 15 U.S.C § 1052(d), and to cause damage to Petitioner thereby.

SECOND GROUND FOR CANCELLATION – FRAUD

26. Petitioner hereby incorporates by reference paragraphs 1 through 25 as if fully stated here.

24,27. Karen M. Sandler, an attorney, was employed by Petitioner at the time Petitioner registered the SOFTWARE FREEDOM LAW CENTER Mark, and was the ~~correspondent~~attorney of record on behalf of Petitioner in its application and filings for the SOFTWARE FREEDOM LAW CENTER Mark with the USPTO.

25,28. Karen M. Sandler declared in Petitioner's application for the SOFTWARE FREEDOM LAW CENTER trademark that first date of Petitioner's use of the mark was “at least as early as 02/09/2005”.

26,29. Karen M. Sandler signed a declaration stating in part that she was “properly authorized to execute this application on behalf of the applicant” and “that all statements made on information and belief are believed to be true” when filing Petitioner's application for the SOFTWARE FREEDOM LAW CENTER Mark on June 17, 2010.

27,30. On November 29, 2011 Registrant filed a Trademark Application (the “Application”) for the SOFTWARE FREEDOM CONSERVANCY Mark with the USPTO under 15 U.S.C. Section 1051(a)

which included a ~~sworn~~ declaration signed ~~under penalty of perjury~~ by Registrant's general counsel.

Anthony K. Sebro, Jr. attesting to

the truth of the statements made in the Application and acknowledging “that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom... .”

28.31. On April 10, 2012 Registrant filed a Response to Office Action (the “Response”) in relation to the Application with the U.S. Trademark Office which included a ~~sworn declaration signed under—~~
~~penalty of perjury by Registrant's general counsel.~~declaration signed by Registrant's general counsel
attesting to the truth of the statements made in the Response and acknowledging “that willful false
statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and
that such willful false statements and the like may jeopardize the validity of the application or
submission or any registration resulting therefrom... .”

29.32. The Secretary of Registrant's Board of Directors at the time Registration filed the Application and Response was Karen M. Sandler.

30.33. Bradley M. Kuhn was the President and Chairperson of Registrant's Board of Directors, as well as the Executive Director of Registrant at the time Registrant filed the ~~Application~~Appcation and Response ~~was Bradley M. Kuhn.~~

34. ~~Registrant swore~~Registrant, through its board of directors and executive director, instructed its
general counsel to apply for the SOFTWARE FREEDOM CONSERVANCY Mark.

31.35. Registrant declared, through its general counsel, in both the Application and Response that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”

36. As of October 12, 2011, Registrant began providing legal advice and services in connection

with the SOFTWARE FREEDOM CONSERVANCY Mark, as its website shows.

37. Registrant provided legal services in connection with the SOFTWARE FREEDOM

CONSERVANCY Mark at the time Registrant applied for the mark.

38. Registrant did not disclose to the USPTO, in either its Application or Response, that Registrant provided legal advice and services in connection with the SOFTWARE FREEDOM CONSERVANCY Mark.

39. Registrant had actual knowledge that Petitioner provided legal services in connection with the SOFTWARE FREEDOM LAW CENTER Mark at the time Registrant applied for the SOFTWARE FREEDOM CONSERVANCY Mark.

40. Registrant used the broad term “defending” to describe its charitable services in regards to “free, libre and open source software projects” and did not adequately specify to the USPTO that Registrant provided legal services. The Registrant did not list class 45 as it should have, as that would have alerted the examining attorney to confusion with the SOFTWARE FREEDOM LAW CENTER Mark.

41. Registrant knew that the statements it made in paragraph 35 above in its Application and Response were false at the time they were made because Registrant knew that Petitioner's rights in the SOFTWARE FREEDOM LAW CENTER Mark predated any rights that Respondent could assert in its SOFTWARE FREEDOM CONSERVANCY Mark.

42. Registrant knew that the statements it made in paragraph 35 above in its Application and Response were false at the time they were made because Registrant knew that Petitioner had rights to the SOFTWARE FREEDOM CONSERVANCY Mark.

43. Registrant knew that the statements it made in paragraph 35 above in its Application and Response were false at the time they were made because Registrant knew that there was actual confusion between Petitioner's SOFTWARE FREEDOM LAW CENTER Mark and Registrant's SOFTWARE FREEDOM CONSERVANCY Mark in connection with the services provided by Petitioner.

44. Registrant's willful failure to disclose to the USPTO in its Application that it provided legal advice and services in connection with the SOFTWARE FREEDOM CONSERVANCY Mark, and its decision to instead use the broad term "defending" to describe its activities evinces Registrant's bad faith and that it intended to obtain a trademark registration to which it was not entitled because Registrant knew Petitioner was using the confusingly similar mark SOFTWARE FREEDOM LAW CENTER for legal services.

45. Registrant's willful failure to disclose in its Application and Response that it had knowledge of actual confusion between Petitioner's and Registrant's marks and that Petitioner had prior legal rights to a mark that is confusingly similar to Registrant's mark evinces Registrant's bad faith and that it intended to obtain a trademark registration to which it was not entitled.

46. The USPTO examining attorney relied on the false statements that Registrant made in paragraph 35 above in its Application and Response in deciding whether or not to grant Registrant registration of the SOFTWARE FREEDOM CONSERVANCY Mark.

47. The USPTO examining attorney relied on Registrant's false identification of its goods and services in its Application and Response as being adequate to provide public notice and to enable the examining attorney to reach an informed judgment concerning the likelihood of confusion.

48. On November 2, 2017, the same day that Registrant filed its Answer in the instant action, Registrant filed trademark applications on a Section 1(b) intent-to-use basis for the word mark THE SOFTWARE CONSERVANCY (serial number 87670034), and for a design mark with the literal element THE SOFTWARE CONSERVANCY (serial number 87670106) ("THE SOFTWARE CONSERVANCY Marks").

49. Registrant applied for THE SOFTWARE CONSERVANCY Marks in the identical international classes and for the identical goods/services as the SOFTWARE FREEDOM CONSERVANCY Mark.

50. Registrant declared, inter alia, through its general counsel, Anthony K. Sebro, Jr., in its

applications for THE SOFTWARE CONSERVANCY Marks, that “the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application.”

51. Registrant’s SOFTWARE FREEDOM CONSERVANCY Mark should be canceled because Registrant fraudulently obtained registration of its mark from the USPTO.

WHEREFORE, Petitioner respectfully prays that its cancellation be sustained and that Registrant's Registration no. 4,212,971 be canceled in its entirety and that this Court grant such other and further relief as it shall deem just.

Dated: ~~September~~December

22, 2017 New York, New York

Respectfully submitted,

/S/
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